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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,761	09/01/2000	Stephen P. A. Fodor	2719.2004-000	6146
33880	7590	03/25/2004	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742			PONNALURI, PADMASHRI	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/653,761	FODOR ET AL.
Examiner	Art Unit	
Padmashri Ponnaluri	1639	

**- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 20 January 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 172-212 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 172-212 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 02 August 2001 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. The amendment and the response filed on 1/20/04 has been fully considered and entered into the application.
2. Claims 172-212 are currently being examined in this application.

### ***Withdrawn Claim Rejections***

3. In view of applicants arguments and amendments the objection to the abstract and 112, second paragraph rejections set forth in the previous office action have been withdrawn.
4. The obviousness-type double patenting rejections over US Patents 6,416,952 and 6,506,558 have been withdrawn in view of TDs filed on 12/10/03.

### ***Maintained Claim Rejections***

5. The obviousness type double patenting rejections over US patents 5,384,261 and 5,677,195 have been maintained for the reasons of record.

### ***Response to Arguments***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. *Claims 172-212 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,384,261. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims are drawn to a method of forming a plurality of peptide sequences on a surface of a single substrate, which would result in an array of polypeptides of the instant claims.*

8. *Claims 171-212 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 5,677,195. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims are drawn to a method of forming oligonucleotide or peptides having a diverse sequences on a single substrate and the formed peptides on a surface according to the reference method would read on the instantly claimed substrate or an polypeptide array.*

9. Applicant's arguments filed on 1/20/04, regarding obviousness-type double patenting over US Patents 5,384,261 and 5,677,195 have been fully considered but they are not persuasive.

Applicants have argued both the rejections together. Applicants argue that the cited claims of '195 are directed to methods of forming oligonucleotides or peptides having diverse sequences on a single substrate. In contrast, claims 172-212 are directed to a variety of substrates or supports with a surface comprising a plurality of peptides bound to the surface.

Applicant's arguments have been considered and are not persuasive, since the reference claims are drawn to a method of forming oligonucleotides or peptides having diverse sequences on a substrate, which would result in an array of polypeptides or substrate with a surface comprising a plurality of peptides. Contrary to applicant's arguments, the instant claims are not drawn to a variety of substrates or supports. The instant claims are drawn to 'a substrate with a surface comprising a plurality of peptides' (claim 172), and 'an array of more than 1,000 different polypeptides with known sequences bound to a surface of a substrate' (claims 185). Thus the reference method would result in the array of the instant claims. If applicants argue that the reference method would not result in the array of the instant claims, applicants are requested to provide evidence.

Applicants further argue that claim 189 and 207, which recite method steps. Applicants are requested to note that these claims are drawn to product-by-process claims. Claims 189, 207 are drawn to array of polypeptides prepared by the methods steps, however these claims are considered as drawn to product claims. And the arguments regarding the ‘with/without the physical segregation’ are not persuasive. And the rejections of record have been maintained.

*Conclusion*

10. No claims are allowed.
11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

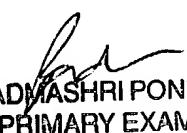
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 571-272-0809. The examiner is on Increased Flex Schedule and can normally be reached on Monday through Friday between 7 AM and 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Padmashri Ponnaluri  
Primary Examiner  
Art Unit 1639

Pp  
24 March 2004



PADMASHRI PONNALURI  
PRIMARY EXAMINER